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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS SUNGA FERNANDEZ and IRENE HU FERNANDEZ

Appeal 2009-012029
Application 09/145,167
Technology Center 3600

Decided: February 12, 2010

Before JAMES T. MOORE, *Vice Chief Administrative Patent Judge*, and
ANTON W. FETTING, and KEVIN F. TURNER, *Administrative Patent
Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the Final Rejection of claims 21-26. We have jurisdiction under 35 U.S.C. § 6(b).

An appeal was previously taken in this application, Appeal No. 2001-2427, decided Jul. 31, 2003, affirming all of the Examiner's rejections. The issues decided in that decision are separate and distinct, and not germane to the instant appeal.

Additionally, a Divisional Application 09/952,285, of the present Application, issued as U.S. Patent no. 6,963,899, on November 8, 2005. The Appeal Brief indicates (App. Br. 3) that this patent was asserted in *Fernandez Innovative Technologies, L.L.C. v. General Motors Corporation*, No. 1:2007cv01397 (N.D. Ill. filed Mar. 12, 2007). This case was appealed and affirmed, under Fed. Cir. R. 36, *Fernandez Innovative Technologies, L.L.C. v. General Motors Corporation*, No. 2008-1533 (Fed. Cir. Jun. 11, 2009).

Lastly, a Divisional Application 09/952,329, of the present Application, is currently on appeal, Appeal No. 2009-006531, and is being concurrently decided.

SUMMARY OF THE DECISION

We REVERSE.¹

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Sep. 27, 2007) and Reply Brief ("Reply Br.," filed Jan. 14, 2008), and the Examiner's Answer ("Ans.," mailed Dec. 31, 2007).

THE INVENTION

Appellants' claimed invention relates an interactive digital television set-top method and apparatus for providing contextually-mapped biomedical media service over a video stream. (Spec. 14, 16). The system operates by generating a personal biological sensor signal based on a micromachined transducer coupled to a diagnosed patient for measuring or monitoring an organic material of the patient coupled to the sensor transducer that senses the organic material. (Spec. 14). This signal enables set-top classification of the patient into a promotional group for targeted biomedical expertise messaging. (Claim 21).

Independent claim 21, which is deemed to be representative, reads as follows:

21. An interactive digital television set-top apparatus for coupling to a network for providing contextually-mapped biomedical media service comprising:
 - an interface for receiving a video stream from the network;
 - a controller for causing the video stream to be stored in a digital video recorder, such stored video being accessible for play-back using a software search agent; and
 - a personal biological sensor for generating a real-time signal for transmission via the network interface, the real-time signal enabling such set-top apparatus to be classified in a promotional group for targeted messaging, whereby a promotion video stream is directed to the set-top apparatus adaptively in response to the real-time signal, the received video stream comprising a biomedical expertise message for clinical diagnosis that is contextually mapped to a patient group by comparing automatically with an associated value stored in a

database a patient diagnosis sensed using the sensor comprising a micromachined transducer coupled to a diagnosed patient for measuring or monitoring an organic material of the patient coupled to the sensor transducer that senses the organic material, such that the sensor transducer generates therefrom the personal biological sensor signal for enabling such patient to be diagnosed via the biomedical expertise message that is adapted to the personal biological sensor signal measurement or monitoring of the organic material as generated by the sensor transducer, the biomedical expertise message being scheduled for viewing by one or more patients belonging to the patient group, the patient or promotional group being determined automatically by software for group analysis overlay that monitors patient sensor or sensor interface to process patient attribute in either group by comparing patient attribute with associated attribute stored in the database.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hill et al.	5,857,155	Jan. 5, 1999
Ballantyne et al.	5,867,821	Feb. 2, 1999
Peifer et al.	5,987,519	Nov. 16, 1999
Alexander et al.	6,177,931 B1	Jan. 23, 2001

The Examiner rejected claims 21, 22, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Alexander, Ballantyne, and Peifer. Additionally, the Examiner rejected claims 23 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Alexander, Ballantyne, Peifer, and Hill.

Appellant relied upon the following in rebuttal to the Examiner's rejection:

Wood, Fiona, Prior, Lindsay & Gray, Jonathon, *Translations of risk: decision making in a cancer genetics service*, Health, Risk & Society, vol. 5 no. 2, 1369-8575. (2003), available at <http://www.informaworld.com> (last visited Jan. 11, 2010).

ARGUMENTS

The Examiner took the position that the combination of Alexander Ballantyne, and Peifer makes obvious the limitations recited in claims 21, 22, 24, and 25. (Ans. 3). The Examiner found that “[e]ven though the Applicant's [sic] invention has biomedical elements included in the claims, the main focus of the Applicant's [sic] invention is directed to providing patients with targeted promotion video streams to set-top apparatus according to the patients' data.” (Ans. 15). Thus, the Examiner concluded, “[i]t would have been obvious to one of ordinary skill in the art at the time of the applicant's [sic] invention to incorporate biomedical expertise message for clinical diagnosis [as taught by Ballantyne] into an interactive digital television set-top apparatus [as disclosed by Alexander] with the motivation of allowing targeted messaging in a biomedical environment.” (Ans. 6).

Appellants argue *inter alia* that “. . . the Examiner unreasonably combined the Alexander and Ballantyne references, in particular, to reject the claimed invention as obvious under § 103.” (App. Br. 12). Specifically, Appellants argue that “. . . the Examiner offered conclusory statements, that Alexander and Ballantyne would be obvious to combine due to ‘motivation of allowing targeted messaging in a biomedical environment,’ without

articulating some rational underpinning to support the legal conclusion of obviousness.” (App. Br. 12) (referring to Ans. 6).

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

1. Have Appellants shown the Examiner erred in combining Alexander, Ballantyne, and Peifer under 35 U.S.C. § 103(a) because the Examiner did not articulate some rational underpinning to support the legal conclusion of obviousness?
2. Have Appellants shown reversible error in that Hill fails to cure the deficiencies in the combination of Alexander, Ballantyne, and Peifer under 35 U.S.C. § 103(a), as recited in claims 23 and 26?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

Claim Interpretation

1. Appellants have not provided a lexicographic definition of a “biomedical expertise message.”
2. The definition of “biomedical” is “2. [o]f, relating to, or involving biological, medical, and physical sciences.”²
3. Appellants’ Specification refers to a “message” as targeted on-line messages or electronic network signals. (p. 6, ll. 1-3).
4. Under the broadest reasonable interpretation, consistent with Appellants’ Specification, we find a “biomedical expertise message” to be a targeted on-line message relating to, or involving biological, medical, and physical sciences.

Alexander

5. Alexander is directed to an electronic programming guide which can utilize a viewer’s profile to provide customized presentation of advertising to that viewer. (Abs.).
6. Alexander’s system utilizes user profiles to deliver customized advertisements during programming. These advertisements are displayed based on an electronic trigger transmitted within the television signal which identifies the applicable advertisement stored in the user terminal. (col. 32, ll. 51-54).

² *Biomedical Definition*, Merriam-Webster’s Medical Dictionary, <http://dictionary.reference.com/browse/biomedical> (last visited Jan 11, 2010).

7. Alexander describes that user profile information is captured and updated on an ongoing basis, based upon the viewer profile analysis program. (col. 29, ll. 22-30).

8. Alexander describes an automatic surfing feature which transmits advertisements based on statistics collected from user profiles. (col. 31, ll. 9-14).

Ballantyne

9. Ballantyne is directed to a method and system “. . . for the distribution and administration of medical services, entertainment services, electronic medical records, educational information, etc. to a patient's individual electronic patient care station (PCS). . .” (Abs.).

10. The PCS of Ballantyne, is comprised of a monitor and interface interconnected to a master library (ML) which stores data and operates over a local medical information network. (col. 9, ll. 1-15).

11. Ballantyne discloses, “[t]he interactive capability of the PCS allows the patient to order/select various services including meal selection, selection of a variety of entertainment packages including regular TV programming, movie videos on demand, video games, educational information, clinical data that the patient has been allowed to access. . .” (col. 9, ll. 32-40).

Peifer

12. Peifer is directed to a telemedicine system for communicating video, voice and medical data between a central monitoring station and a

patient monitoring station which is remotely-located with respect to the central monitoring station. (Abs.).

Hill

13. Hill is directed a selective call transceiver in a messaging system comprising a GPS receiver for receiving GPS information for delivering targeted messages based on the geographic information received. (Abs., col. 2, ll. 31-38).

PRINCIPLES OF LAW

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss [v. Greenwood*, 52 U.S. 248 (1850)].” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

ISSUE 1

Claims 21, 22, 24, and 25 rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander, Ballantyne, and Peifer.

Independent claims 21 and 24

Appellants generally argue that the combination of Alexander, Ballantyne, and Peifer does not render obvious limitations recited in claims 21, 22, 24, and 25. (App. Br. 10). Specifically, Appellants argue, *inter alia*, that the Examiner combined the Alexander and Ballantyne references without articulating some rational underpinning to support the legal conclusion of obviousness. (App. Br. 12). In response to this argument, the Examiner found that “Alexander et al, Ballantyne et al and Peifer et al. are all directed to the analogous art of delivering targeted video messages to customers.” (Ans. 17). The Examiner went on to say, “[t]herefore, the combination of Alexander et al, Ballantyne et al and Peifer et al is proper under the KSR test in that all the elements are well known in the message delivering arts and the elements when combined still perform the same functions as originally disclosed to arrive at a predictable result, which is delivering targeted video messages to customers.” (Ans. 17). We cannot agree.

We find that Alexander is directed to an electronic programming guide that utilizes a viewer’s profile targeted advertising (FF 5, 6, 7, 8). Additionally, we find that Ballantyne is directed to an electronic patient care station which provides entertainment services and access to electronic

medical records on a patient's monitor. (FF 9, 10, 11). However, as Appellants' suggest, Alexander is directed to a non-biomedical function, and Ballantyne is directed to a biomedical function. (App. Br. 13).

Consequently, while the Examiner may be correct that both Alexander and Ballantyne deliver video to customers, we find that only Alexander delivers targeted videos to customers. (FF 5, 6). Notwithstanding, we find that the targeted videos in Alexander are based on a user's viewing profile (FF 7, 8), and thus behaviors of a viewer, rather than based on "... a patient diagnosis sensed using the sensor comprising a micromachined transducer coupled to a diagnosed patient for measuring or monitoring an organic material of the patient . . ." as Appellants recite in independent claims 21 and 24.

Similarly, while Ballantyne does provide the patient with medical records through the patients' TV over a network (FF 10, 11), we do not find that it suggests that targeted messages be supplied to the patient based on signals from a personal biological sensor. The Examiner states the reason to combine Alexander and Ballantyne would be for "allowing targeted messaging in a biomedical environment." (Ans. 6). We find the Examiner's rationale to be a conclusory statement to support the legal conclusion of obviousness. Therefore, we find the Examiner has not provided an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, as required by KSR.

Accordingly, we conclude that Appellants have shown that the Examiner erred in rejecting claims 21 and 24 under 35 U.S.C. § 103(a) as being obvious over Alexander, Ballantyne, and Peifer. As such, we find that

the rejections of claims 22 and 25 were also made in error for the same reasons discussed *supra*.

ISSUE 2

*Claims 23 and 26 rejected under 35 U.S.C. § 103(a)
as being unpatentable over Alexander, Ballantyne, Peifer, and Hill.*

Appellants do not separately argue claims 23 and 26, which depend from claims 21 and 24 respectively. As discussed *supra*, Appellants have shown that the Examiner erred in rejecting claims 21 and 24 under 35 U.S.C. § 103(a) as being obvious over Alexander and Ballantyne. As such, we find that the rejections of claims 23 and 26, which depend from claims 21 and 24 respectively, were also made in error for the same reasons discussed *supra*.

CONCLUSIONS OF LAW

1. We conclude that Appellants have shown the Examiner erred in combining Alexander, Ballantyne, and Peifer under 35 U.S.C. § 103(a) because the Examiner failed to articulate some rational underpinning to support the legal conclusion of obviousness.
2. We conclude that Appellants have shown reversible error in that Hill fails to cure the deficiencies in the combination of Alexander, Ballantyne, and Peifer under 35 U.S.C. § 103(a), as recited in claims 23 and 26.

Appeal 2009-012029
Application 09/145,167

DECISION

The decision of the Examiner to reject claims 21-26 is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

REVERSED

cc:

ack

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